

REMARKS

Applicants acknowledge receipt of a Final Office Action dated March 27, 2008. In this response, Applicants have amended claim 13 and have added claim 22. Following entry of these amendments, claims 2-16, 18, and 21 are pending in the application.

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Rejection Under 35 U.S.C. § 102

On page 2 of the Office Action, the PTO has rejected claims 2-4, 6, 8, 9 and 18 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent 2,870,235 to Soltis (hereafter “Soltis”). Applicant traverse this rejection for the reason set forth below.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See generally MPEP § 2131.

Here, Soltis fails to disclose “a packing case for accommodating the battery cell which is provided with an opening to expose the electrode tab of the battery cell to the outside of the packing case” as recited in claim 13.

In this regard, Applicants note that sealed “battery packs” of Soltis correspond to the kind of structure referred to as “battery cells” in the present claims and that the “insulating wrapper 20” of Soltis corresponds to the film (depicted by way of example at reference numerals 12, 13) of the present claims. Thus, Soltis does not disclose the presently claimed “packing case for accommodating the battery cell which is provided with an opening to expose the electrode tab of the battery cell to the outside of the packing case” and therefore cannot properly anticipate independent claim 13 or any claim depending therefrom.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under § 102.

Rejection Under 35 U.S.C. § 103

On page 3 of the Office Action, the PTO has rejected claim 5 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent 2,870,235 to Soltis (hereafter “Soltis”) in view of U.S. Patent 6,821,671 to Hinton (hereafter “Hinton”).

In addition, on page 4 of the Office Action, the PTO has rejected claim 7 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Soltis in view of U.S. Patent 5,688,615 to Mrotek (hereafter “Mrotek”).

Also on page 4 of the Office Action, the PTO has rejected claims 10, 11, and 13 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent 6,733,848 to Nortoft (hereafter “Nortoft”) in view of U.S. Patent 5,445,856 to Chaloner-Gill (hereafter “Chaloner-Gill”).

Finally, on page 6 of the Office Action, the PTO has rejected claim 12 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nortoft in view of Chaloner-Gill and further in view of U.S. Patent 5,879,831 to Ovshinsky (hereafter “Ovshinsky”).

Applicants traverse these rejections for the reasons set forth below.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants’ disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Here, Soltis, Hinton, Mrotek, Nortoft, Chaloner-Gill, and Ovshinsky, whether taken individually or in combination, fail to teach or suggest a “a packing case for accommodating the battery cell which is provided with an opening to expose the electrode tab of the battery cell to the outside of the packing case” as recited in independent claim 13. For at least this reason, Applicants submit that the outstanding rejections based upon the various combinations of, Soltis, Hinton, Mrotek, Nortoft, Chaloner-Gill, and Ovshinsky are improper and ought to be withdrawn.

As discussed above with regard to Soltis, the sealed “battery packs” of Soltis correspond to the kind of structure referred to as “battery cells” in the present claims and that the “insulating wrapper” 20 of Soltis corresponds to the film (depicted by way of example at reference numerals 12, 13) of the present claims.

With regard to Chaloner-Gill, Applicants note that the sealed “battery packs” of Chaloner-Gill correspond to the kind of structure referred to as “battery cells” in the present claims and that the “exterior layers” 40, 42 of Chaloner-Gill correspond to the film (depicted by way of example at reference numerals 12, 13) of the present claims.

The remaining references fail to add anything to resolve these fundamental deficiencies in Soltis and Chaloner-Gill.

If an independent claim is nonobvious under § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). See MPEP 2143.03. Thus, Applicant submits that claims 5, 7, and 10-12, each of which ultimately depends from independent claim 13, are also non-obvious at least by virtue of their dependency from claim 13.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections under § 103.

Newly Added Claim

In this response, Applicants have added claim 22. Applicants submit that claim 22 is allowable for at least the same reasons as claim 13, from which it depends, and because none of the cited references, taken either individually or in combination, teach or suggest “a battery pack holder which holds the stacked battery packs together, wherein each of the openings of the packing cases are covered with the battery pack holder so as to make the stacked battery packs air tight.”

CONCLUSION

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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